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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(OAKLAND DIVISION)

FINJAN LLC,

Plaintiff,

v.

PALO ALTO NETWORKS, INC.,

Defendant.

Case No. 4:14-cv-04908-PJH

**JOINT STIPULATION RE DISMISSAL
OF THREE PATENTS-IN-SUIT**

Hon. Phyllis J. Hamilton
Ctm: 3, 3rd Floor

1 Plaintiff Finjan LLC (“Finjan”) and Defendant Palo Alto Networks, Inc. (“PAN”) hereby
2 agree and stipulate:

3 In Finjan’s case against ESET, LLC, pending in the United States District Court for the
4 Southern District of California, Judge Bencivengo found that the asserted claims of U.S. Patent No.
5 6,804,780 (“the ’780 Patent”) and four other Finjan patents are invalid on the grounds that the claim
6 term “Downloadable,” as used in those claims and construed by that court, is indefinite. *Finjan,*
7 *Inc. v. ESET, LLC*, No. 3:17-cv-0183-CAB-BGS, Dkt. No. 869 (S.D. Cal. Mar. 29, 2021). Based
8 on that order, Judge Bencivengo entered judgment of invalidity with regard to those patents. *Id.* at
9 Dkt. No. 875 (May 20, 2021). Finjan has filed a notice of appeal of that judgment to the Federal
10 Circuit. *Id.* at Dkt. No. 878 (June 17, 2021).

11 Finjan has asserted the ’780 Patent in this case against PAN. Finjan also has asserted two
12 other patents that—although not asserted in *ESET* and therefore not included in Judge Bencivengo’s
13 order and judgment—also use the claim term “Downloadable,” namely U.S. Patent No. 7,613,926
14 (“the ’926 Patent”) and U.S. Patent No. 8,677,494 (“the ’494 Patent”).

15 In light of Judge Bencivengo’s order and judgment, the parties have agreed to dismissal of
16 Finjan’s claims of infringement of the ’780 Patent (Counts I and II of Dkt. No. 112), the ’926 Patent
17 (Counts V and VI), and the ’494 Patent (Counts XIII and XIV) on the following terms:

18 1. In the event the judgment of invalidity of the ’780 patent becomes final without any further
19 appeal, the dismissal shall then be with prejudice; and

20 2. The dismissal shall be without prejudice to Finjan’s reassertion of infringement claims on
21 these three patents against PAN if and only if the judgment of invalidity of the ’780 patent is reversed
22 or vacated on appeal.

23 If Finjan reasserts its infringement claims on these three patents against PAN after the
24 invalidity judgment against the ’780 Patent is reversed or vacated, PAN agrees the time limitation
25 on damages under 35 U.S.C. § 286 will be tolled and the date for filing of the reasserted infringement
26 claims for the purposes of 35 U.S.C. § 286 shall be the date of filing of the original complaint in
27 this present action.

28 Likewise, the parties have agreed to dismissal without prejudice of PAN’s counterclaims

(Counts I, II, V, VI, XIII and XIV of Dkt. No. 116) and defenses for the '780, '926, and '494 Patents.

Each party shall bear its own costs and fees pertaining to the dismissed patents.

IT IS SO STIPULATED, THROUGH COUNSEL OF RECORD.

Dated: June 21, 2021

Respectfully Submitted,

/s/ Roger A. Denning

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ATTESTATION PURSUANT TO CIVIL L.R. 5-1(i)

In accordance with Civil Local Rule 5-1(i)(3), I attest that concurrence in the filing of this document has been obtained from any other signatory to this document.

/s/ Roger A. Denning
Roger A. Denning